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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,590	09/05/2003	Peter Anthony Drake	P69121US0	7327
136	7590	04/05/2006	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			ADAMS, GREGORY W	
			ART UNIT	PAPER NUMBER
			3652	

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/655,590

Applicant(s)

DRAKE, PETER ANTHONY

Examiner

Gregory W. Adams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 7, 9-10, 15, 17 & 22 are rejected under 35 U.S.C. 102(a) as being unpatentable over (DE 1286962) (cited by applicant) in view of Brouwer et al. (US 5,879,124).

DE '962 discloses 3 wheels, driver station, a motorized drive on a side leg, telescopic mast 4, 5 mounted to a support frame, telescopic boom 6, 7, means for moving a boom up and down, lifting forks 9 mounted on a fork carrier, and means for extending or reducing boom length.

DE '962 does not disclose means for moving a mast side to side, tilting ram, support frame and rollers. Brouwer et al. discloses means for moving 156 a mast back and forth between side legs 16 comprising mounting a mast 160 to support frame pivot, tilting ram 226, rollers 134, mounting a support frame in each side leg and a frame moving frame connected between a rear leg and support frame For forklift vehicle length reduction for more easily carrying at the rear end of another vehicle. Col. 1, Ins.5-36. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fork lift of DE '962 to include means for moving a mast side to side, tilting a support frame and rollers, as per the teachings of

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Brouwer et al., such that the fork lift length can be reduced or modified for more easily carrying at the rear end of another vehicle.

2. Claims 3, 11, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1286962) in view of Brouwer et al. (US 5,879,124) and Ehmann (US 2,915,210).

DE '962 does not disclose a mast inner and outer portion. Ehmann discloses a mast comprising a lower inner portion 18 and an upper outer portion 19 and a ram 51 housed within an inner portion to increase driver visibility. Col. 1, Ins. 16-48. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the forklift of DE '962 to include an inner and outer mast with a ram, as per the teachings of Ehmann, such that the driver's visibility is improved.

3. Claims 4, 12, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1286962) in view of Brouwer et al. (US 5,879,124) and Ehmann (US 2,915,210).

DE '962 does not disclose a mast inner and outer portion. Ehmann discloses a mast comprising a lower inner portion 18 and an upper outer portion 19 and a ram 51 housed within an inner portion to increase driver visibility. Col. 1, Ins. 16-48. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the forklift of DE '962 to include an inner and outer mast with a ram, as per the teachings of Ehmann, such that the driver's visibility is improved.

DE '962 does not disclose a pair of drive chains. Brouwer discloses a pair of drive chains or forklift vehicle length reduction for more easily carrying at the rear end of another vehicle. Col. 1, Ins.5-36. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fork lift of DE

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'962 to include a pair of drive chains, as per the teachings of Brouwer et al., such that the fork lift length can be reduced or modified for more easily carrying at the rear end of another vehicle.

4. Claims 5, 13, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1286962) in view of in view of Brouwer et al. (US 5,879,124), Ehmann (US 2,915,210) and Sinclair (US 3,782,503).

DE '962 does not disclose a mast inner and outer portion. Ehmann discloses a mast comprising a lower inner portion 18 and an upper outer portion 19 and a ram 51 housed within an inner portion to increase driver visibility. Col. 1, Ins. 16-48. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the forklift of DE '962 to include an inner and outer mast with a ram, as per the teachings of Ehmann, such that the driver's visibility is improved.

DE '962 does not disclose an endless drive chain. Sinclair discloses an endless drive chain 40 for side-to-side stability for fork trucks lifting loads which are not positioned in front of a mast. Col. 1, Ins. 11-42. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the forklift of DE '962 to include an endless drive chain, as per the teachings of Sinclair, for side-to-side stability when forking loads which are not in front of a mast.

5. Claims 6, 14, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1286962) in view of Brouwer et al. (US 5,879,124) and Turturro et al. (US 3,233,768). DE '962 discloses a boom 7 and a mast sleeve 6 but does not disclose a ram connected between a sleeve and boom. Turturro et al. discloses a ram 26

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connected between a sleeve 71 and boom 24 to maintain a boom in a horizontal position for stable lifting such that the load is protected from stress-induced damaged.

Col. 1, Ins. 15-49. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fork lift boom of DE '962 to include a ram, as per the teachings of Turturro et al., for stable lifting and loading.

6. Claims 8, 16, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over (DE 1286962) in view of Brouwer et al. (US 5,879,124) and Nakagawa (US 4,382,604). DE '962 does not disclose wheels raised by rams. Nakagawa discloses wheels 1 which raise and lower via a ram 5 in response to axle-tilting displacement of the wheels as they rise and lower in turn in opposition to each other. Col. 1, Ins. 13-64. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of DE '962 to include rams to raise wheels, as per the teachings of Nakagawa, such that a vehicle will respond to axle-tilting displacement.

Response to Arguments

Applicant's arguments filed Feb. 21, 2006 have been fully considered but they are not persuasive.

Initially Applicant argues that the cited prior art does not disclose a piggyback forklift having a U-shaped chassis. It is not contended that the cited prior art can or cannot work in a "piggyback" fashion (however that is defined) because Applicant neither claims a --piggyback forklift-- nor defines structure which would define Applicant's invention over the prior art to avoid stresses or boom overhang during transport. The Examiner appreciates the Applicant's inclusion of a general discussion of

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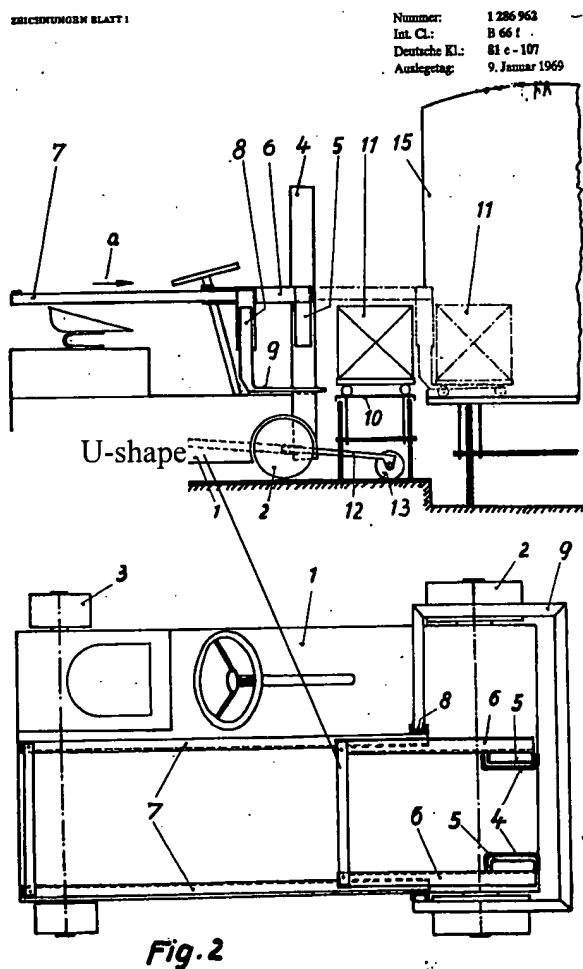
piggyback forklifts, but respectfully reminds the Applicant that when submitting evidence of secondary considerations to include an affidavit which amounts to more than an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. Thus, a recitation of the intended use of the claimed invention, e.g. “a forklift for mounting on the rear of a carrying vehicle”, must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the cited prior could certainly piggyback another vehicle for at least the reason that forks will fit in the pockets of a truck.

Further, merely claiming a –piggyback forklift— does not define over the cited prior art because it could mean that a forklift is carried on top of a carrying vehicle (e.g. US 5,876,175 to Braud or US 4,435,113 to Mosely et al.) or that a forklift is carried on the end of a carrying vehicle by placing forks into pocket receptacles located on a carrying vehicle (e.g. US 5,879,124 to Brouwer et al.). In this case, the cited prior art has wheels to rest on a carrying vehicle and has forks that fit in pockets.

The cited prior art includes a U-shape (see FIG. 2 below), and with respect to “only three wheels”, Applicant’s invention is not limited to a particular number because the preamble does not include the language “consisting of” which would preclude any additional structure beyond that of Applicant’s. Further, arguments that the cited prior art does not have the “lifting capability” of Applicant’s is unclear because it doesn’t recite

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structure which defines over the cited prior art much less quantify a particular number or range much less a "reduced lifting weight."



Further, in response to applicant's argument that the combination of Butter (DE 1286962) in view of Brouwer is not obvious because Brouwer is aimed at overhang whereas Butter is not, the fact that applicant has recognized a disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*,

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227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Moreover, Brouwer's curing of any potential overhang is irrelevant because Brouwer adds the feature of moving a mast side-to-side for lateral adjustment of off-center load. Finally, Brouwer is properly combined with Butter for at least the reason that both comprise fork lifts.

With respect to claims 1, 2, 7, 9-10, 15, 17 & 22 Applicant argues that the cited prior does not include a drive mounted on the other side leg. By virtue of Butter including a drive in body 1, although mounted to all wheel legs, the drive is at least mounted to one leg opposite a driver. Further, "opposite" means at least another leg, which Butter discloses. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brouwer cures the problem of being able to transport a forklift on a second vehicle by adding tilting. The fact that "the forklift of DE 1286962 is not in any way intended for [piggybacking] and would not be suitable for such a purpose" (Applicant's Remarks, page 16, last paragraph), only strengthens the motivation for combining the cited prior art as it is Brouwer that recognized the problems that existed in the art to that time.

Regarding claims 3-5, 11-13 & 18-20, with respect to telescoping mast or boom Butter discloses that a mast 4, 5 and boom 6, 7 "can consist of several telescoping parts

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that can be driven in and out that are arranged so that they can slide into each other as desired and in a known way.” (Translated from Butter DE1286962, C3/L45-50.) With respect to an intended purpose of a chain, the purpose of the chain in the cited prior art as Applicant argues, e.g. “the continuous chain [of Applicant’s invention]...is used to raise and lower the boom relative the mast and not to improve side to side stability with off center loads” (Applicant’s Remarks, page 23, last paragraph), a recitation of the intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case combining a continuous chain to the Butter such that an operator has increased visibility reads on Applicant’s claims.

With respect to claims 7-8, 15-16 & 23, Applicant does not recite a ground engaging wheel –mounted— on a boom but merely “adjacent” to which means in the vicinity. Thus, Butter’s wheel 13 mounted adjacent a boom for support when a boom is extended reads on claims 7 & 15.

With respect to claims 6, 14 & 21, the cited prior art discloses a sleeve 27 slidably mounted on a mast, a boom 28, ram 76 connecting a boom free end such that a mast can expand and retract. C4/L14-16. Turturro solves the problem in that existed in the prior art at the time which was stress-induced lifting member.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W. Adams whose telephone number is (571) 272-8101. The examiner can normally be reached on M-Th., 8:00-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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